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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,838	03/19/2001	Duane D. Miller	20609/181 (PD 98076)	9221

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07/08/2003

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EXAMINER

STOCKTON, LAURA

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 07/08/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/811,838

Applicant(s)

MILLER ET AL.

Examiner

Laura L. Stockton, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1, 3-7 and 12 are pending in the application.

Election/Restrictions

Applicants' election with traverse of Group I, claims 1, 3-7 and 12, and the species of Compound 56a in Paper No. 9 was acknowledged in the previous Office Action. The requirement was deemed proper and made FINAL in the previous Office Action.

The generic concept which has been examined, inclusive of the elected species of Compound 56a, is as follows:

One of X^1 and X^2 is $-Z^1-OP(OH)_2$ and the other is R^1-Y^1-A ;

X^3 is R^1-Y^1-A ;

Z^1 is $-O-$ or $-O(CH_2)_m$ wherein m is 1 to 50;

A is a direct link

Y^1 is NR^2 ; and

R^1 is H, alkyl, alkenyl or acyl.

The generic concept is embraced by claims 1, 3-7 and 12.

Subject matter not embraced by the above identified generic concept is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

Rejections made in the previous Office Action which do not appear below have been overcome. Therefore, arguments pertaining to these rejections will not be addressed.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C.

112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-7 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

No support in the specification or the originally filed claims can be found for the language “R¹ being a straight or branched chain alkyl group, the straight or branched chain alkyl group is a C₅ to C30 alkyl” added at the end of amended claim 1. Applicants state that written description support for the limitation of C5 to C30 alkyl group exists in the definition of R¹ on page 17, which includes the list of suitable alkyl members as “straight or branched chain C1 to C30 alkyl”. In response, the description on page 17 does not support the specific alkyl range of

C5 to C30 but does support the range of C1 to C30 alkyl. Therefore, the claims lack written description as such.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by:

a) Noort et al. {Bioorganic & Medicinal Chemistry Letters

(August 20, 1996), 6(16), pages 2007-2012} – see Compound 2 on page 2008 (or CA Registry No. 90013-43-7);

b) Avaeva et al. {CA 73:31861, 1970} – see CA Registry No.

18942-69-3; and

c) Avaeva et al. {CA 76:34548, 1972} – see CA Registry Nos. 14406-99-6 and 34965-63-4.

Each of the above cited prior art references disclose products embraced by the instant invention.

Response to Arguments

Applicants' arguments filed May 5, 2003 have been fully considered. Applicants argue that the claims, as amended, are not anticipated by the prior art. Specifically, Applicants argue that: (1) Avaeva et al. (1970) and Avaeva et al. (1972) fail to teach or suggest how the compounds disclosed in the references can be prepared; and (2) none of the prior art teach or suggest a compound claimed, because group (ii) in claim 1 explicitly recites "when X^2 is R^1-Y^1-A with A being a direct link, Y^1 being $-NH-$, and R^1 being a straight or branched chain alkyl group, the straight or branched chain alkyl group is a C5 to C30 alkyl group".

All of Applicants' arguments have been considered but have not been found persuasive. Only abstracts of Avaeva et al. (1970) and Avaeva et al. (1972) were cited against the instant claims. It is presumed that the articles themselves would teach how the compounds that anticipate the instant claims are prepared. If Applicants had support that in fact the articles did not teach how the compounds were prepared, Applicants should have submitted this support to the Office with their response.

Additionally, the proviso added at the end of amended claim 1 does not circumvent the cited prior art. For example, see the following comparison of the Noort et al. compound {CA Registry No. 90013-43-7} with the instant claims: X^1 is $-Z^1-PO(OH)_2$, Z^1 is $-O-$, Q^1 is H_2 , Q^2 is $=O$, X^3 is $-A-Y^1-R^1$ wherein A is a direct link, Y^1 is NR^2 , R^2 is acyl and R^1 is hydrogen; X^2 is $-A-Y^1-R^1$ wherein A is a direct link, Y^1 is NR^2 , R^2 is alkyl and R^1 is hydrogen. Therefore, the cited prior art does anticipate Applicants' claimed invention.

Allowable Subject Matter

The elected species of Compound 56a is allowable over the art of record.

Conclusion

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

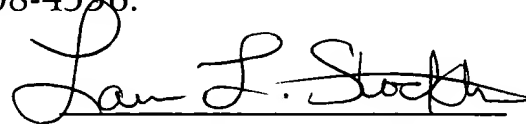
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

This application contains subject matter drawn to inventions nonelected (see the above identified generic concept) with traverse in Paper No. 9. A complete reply, if any, to the final rejection must include cancellation of nonelected subject matter (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", written over a horizontal line.

Laura L. Stockton, Ph.D.
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

July 7, 2003